

### **Remarks/Arguments**

Claims 1, 4-15, and 19-22 are now pending in this application. In the October 30, 2008 Office Action, Claims 1, 4, 5, 7-10, 12-15, 19, 21, and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,467,028 to Piwonka et al. (hereinafter "*Piwonka*") in view of *Teach Yourself Web Publishing with HTML 4 in a Week* (hereinafter "*HTML*"). Claims 6, 11, and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Piwonka* in view of *HTML* further in view of U.S. Patent No. 4,729,678 to Hays et al. (hereinafter "*Hays*").

By this amendment, claim 4 has been cancelled. Claim 1 has been amended. Following entry of this amendment, claims 1, 5-15, and 19-22 will be pending in the present application. For the reasons set forth below, the applicant respectfully request reconsideration and immediate allowance of this application.

### **Examiner's Response to Arguments**

The Office Action mistakenly interprets the applicant's arguments as being "against the references individually." The applicants respectfully maintain that the references, even if combined in the manner suggested by the Office Action, do not teach, suggest, or describe each and every element of the claim. However, it should be noted that the Office Action's own arguments address each reference individually. For example, the Office Action consistently alleges what "*Piwonka* teaches..." or what "*HTML* teaches...." In this regard, the logical response to such allegations is to describe the deficiencies of *Piwonka* and *HTML* with respect to the Office Action's own statements. This approach should not be mistaken as attempting to show non-obviousness by attacking references individually.

In rejecting the claims, the Office Action relies on the "obvious to try" standard for combining *Piwonka* and *HTML*. However, in describing the obvious to try standard, the Office Action still has not addressed significant deficiency with its argument – namely, that the BIOS of *Piwonka* is entirely incapable of reading or understanding *HTML* code. This leads to entirely unpredictable results.

The Office Action at p. 10 alleges that "since *Piwonka* teaches control of displaying strings in a BIOS environment, it would have been a common sense implementation to display

the strings in different formats, so it is somehow different from the surrounding strings. Such an implementation has a clear predictable result of bringing focus or providing contrast to the switch in format” (emphasis in original).” *Piwonka* merely teaches the use of two sets of character strings – one English and one non-English – in a BIOS. These sets of character strings do not utilize BIOS-readable escape code. The Office Action then relies on *HTML* to cure the deficiencies of *Piwonka*. *HTML* teaches the use of tags to format web pages for display through web browsers.

The Office Action first alleges that it would have been a “common sense” implementation to display the strings in different formats. However, this is not the pertinent question. Rather, the pertinent question is whether it would have been common sense to combine the teachings of *Piwonka* with the teachings of *HTML*. The applicant respectfully submits that it would not have been common sense to combine such disparate references. *HTML* discloses a way to control the rendering of web pages, not *BIOS* code. *Piwonka* does not disclose any ability for its BIOS to read or understand *HTML* code.

The Office Action then alleges that implementing the BIOS of *Piwonka* with strings of different formats would yield a predictable result of bringing focus or providing contrast to the switch in format. Again, this is not the pertinent question. Rather, the pertinent question is whether the combination of the teachings of *Piwonka* with the teachings of *HTML* would yield a predictable result. As previously stated, *Piwonka* does not disclose any ability for its BIOS to read or understand *HTML* code. Thus, combining *Piwonka* with *HTML* would yield an inoperable BIOS as the BIOS would cease to function after generating errors attempting to read *HTML* code. This is improper as a proposed modification cannot render the cited references inoperable for its intended purpose (MPEP 2143.01).

The Office Action cites the *KSR* case, which reaffirms the “obvious to try” standard for obviousness. *KSR* held that an “obvious to try” invention may be obvious if at least three other conditions are met: (1) there is a design need or market pressure to solve a particular problem; (2) there are a finite number of foreseeable solutions to the problem; and (3) the result obtained is reasonably predictable. As to the first condition, the Office Action has not established that there is a design need or market pressure to solve the problem addressed by the recited claims. As to the second condition, the Office Action has not established that there are a finite number of foreseeable solutions to the problem. As addressed in the Background of the instant application,

conventional BIOS implementations display text in a basic or fixed format that is non-customizable. The third condition was addressed above as the Office Action has not shown any predictable result when the BIOS of *Piwonka* attempts to read HTML code.

To the extent that the Office Action continues to rely on “obvious to try” for alleging obviousness, the applicant respectfully requests objective evidence establishing, at the time of the invention, the three conditions described in *KSR*: (1) there is a design need or market pressure to solve a particular problem; (2) there are a finite number of foreseeable solutions to the problem; and (3) the result obtained is reasonably predictable. Without an objective showing of these conditions, the applicant respectfully submits that “obvious to try” has not been properly shown.

#### Claim Rejections Under 35 U.S.C. 103(a)

In the Office Action, claims 1, 4, 5 7-10, 12-15, 19-21, and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Piwonka* in view of *HTML*. Claims 6, 11, and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Piwonka* in view of *HTML* further in view of *Hays*. The applicant respectfully submits that the cited references do not separately or together teach, suggest, or describe each recitation of these claims, even if combined in the manner suggested by the Examiner.

#### Claim 1

Amended claim 1 recites, *inter alia*, “when displaying the first string of the set, encountering and interpreting the BIOS-readable first escape code by a display engine of the BIOS to determine the first format and generate the display of the first string with the portion of the first string displayed in the first format during BIOS activity.” The Office Action at p. 2 admits that “*Piwonka* does not explicitly disclose providing a first escape code....” In order to cure the deficiencies of *Piwonka*, the Office Action relies on *HTML*, and in particular, *HTML*’s teaching of well-known style tags to format the text of HTML documents (e.g., web pages).

A substantial flaw in the Office Action’s reliance of *HTML* is that *HTML* can only be interpreted by applications configured to interpret HTML. The most common HTML interpreters are web browsers, such as FIREFOX and INTERNET EXPLORER. To that end, the Office Action has failed to show that a conventional BIOS or the BIOS disclosed in *Piwonka* is

capable of interpreting HTML. Unless the Office Action shows that a BIOS is capable of interpreting HTML in the manner recited in the claims, the Office Action necessarily has not met its burden for establishing *prima facie* obviousness.

The Office Action at p. 2 also admits that *Piwonka* does not disclose a display engine. Neither *Piwonka* nor *HTML*, alone or in combination, describes, teaches, or suggests a “display engine of the BIOS” (emphasis added). In particular, *Piwonka* discloses a BIOS but does not describe a display engine operative to “encounter[] and interpret[] the BIOS-readable first escape code...to determine the first format and generate the display of the first string with the portion of the first string displayed in the first format during BIOS activity.” *HTML* does not disclose any BIOS whatsoever. *HTML* discloses the use of style tags for formatting and displaying web pages, but does not disclose formatting and displaying web pages “during BIOS activity.”

Amended claim 1 further recites “providing a BIOS-readable cancel escape code within the first string and wherein the portion of the first string between the BIOS-readable first escape code and the BIOS-readable cancel escape code is displayed in the first format during BIOS activity”; “providing a BIOS-readable second escape code within the first string of the set, wherein the BIOS-readable second escape code provides an indication of at least a portion of the first string that is to be displayed in a second format during BIOS activity, wherein the portion of the first string between the BIOS-readable first escape code and the BIOS-readable second escape code is displayed in the first format during BIOS activity, and wherein the portion of the first string after the BIOS-readable second escape code is displayed in the second format during BIOS activity”; and “providing a BIOS-readable third escape code within a second string of the set, wherein the BIOS-readable third escape code provides an indication of at least a portion of the second string that is to be displayed in a third format during BIOS activity.” Neither *Piwonka* nor *HTML*, alone or in combination, described, teach, or suggest the “BIOS-readable cancel escape code”, the “BIOS-readable second escape code”, and the “BIOS-readable third escape code” for displaying strings during “BIOS activity.”

Accordingly, *Piwonka* and *HTML*, alone or in combination, do not teach, suggest, or describe each and every element of independent claim 1. The Applicant therefore submits that this claim is in condition for immediate allowance. The Applicant further submits that claims 5-8 are also patentable because they contain recitations not taught by *Piwonka* or *HTML* and

because these claims depend from allowable independent claim 1. Accordingly, the Applicant submits that claims 1 and 5-8 are in condition for immediate allowance.

#### Claim 9

Amended claim 9 recites, *inter alia*, “during power on self-test (POST) or a BIOS SETUP, receiving a request from the BIOS to display a string, the string including a text to be displayed by the BIOS and a BIOS-readable escape code specifying the format in which the text is to be displayed by the BIOS.” Neither *Piwonka* nor *HTML*, alone or combination, describes, teaches or suggests the recited portion of claim 9. *Piwonka* at Abstract discloses the use of a system ROM that includes at least two sets of character strings – one being English and another being a non-English language. *Piwonka* at Abstract further discloses that each of these sets of character strings includes characters, words, and phrases. Nothing in *Piwonka* discloses that the sets of character strings include BIOS-readable escape codes. *HTML* does not disclose any BIOS whatsoever. As such, *HTML* is completely unrelated to the recited portion of claim 9, and in particular, to performing any action “during power on self-test (POST) or a BIOS SETUP.”

Amended claim 9 further recites “parsing the string to determine if the string includes the BIOS-readable escape code.” As previously addressed with respect to claim 1, *HTML* style tags are not “BIOS-readable.”

Accordingly, *Piwonka* and *HTML*, alone or in combination, do not teach, suggest, or describe each and every element of independent claim 9. The Applicant therefore submits that this claim is in condition for immediate allowance. The Applicant further submits that claims 10-11 are also patentable because they contain recitations not taught by *Piwonka* or *HTML* and because these claims depend from allowable independent claim 9. Accordingly, the Applicant submits that claims 9-11 are in condition for immediate allowance.

#### Claim 12

Amended claim 12 recites, *inter alia*, “upon determining that the string does not include the BIOS-readable escape code, displaying, during BIOS activity, the first text in a default format while operating in a default mode of the BIOS” and “upon determining that the string includes the BIOS-readable escape code, switching from the default mode to a graphics mode of the BIOS, and drawing, during BIOS activity, the second text in the format specified by the

BIOS-readable escape code while operating in the graphics mode.” Neither *Piwonka* nor *HTML*, alone or combination, describes, teaches, or suggests the recited portions of claim 12, and in particular, the “default mode of the BIOS” and the “graphics mode of the BIOS.” *Piwonka* at col. 6, lines 19-21 discloses that the BIOS is capable of displaying character strings based on the system ROMS. *Piwonka* does not disclose that the BIOS transitions to any mode in order to display these character strings. Even assuming, *arguendo*, that the BIOS disclosed in *Piwonka* displays character strings in a default mode, nothing in *Piwonka* discloses that the BIOS transitions from the default mode of the BIOS to the graphics mode of the BIOS in order to display text in a format specified by the BIOS-readable escape code. *HTML* does not disclose any BIOS whatsoever, much less a BIOS with a default mode and a graphics mode, as recited in claim 12.

The Office Action at p. 6 alleges that “since *Piwonka*’s BIOS displays strings in text as a default mode, in order to display strings in formatted mode using tags for formatting text as taught by *HTML*, it is inherent for the computer to go to graphics mode in order to display the strings and given that it cannot be done in text mode.” To establish that a reference inherently discloses a specific limitation, the Office Action may refer to extrinsic evidence demonstrating that the descriptive matter missing from the reference is necessarily present in the reference’s disclosure. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Thus, the examiner cannot establish inherency merely by demonstrating that the asserted limitation is probable or possible. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981),

The Office Action has not established that “switching from the default mode to a graphics mode of the BIOS,” as recited in claim 12, necessarily flows from the teachings of *Piwonka* and *HTML*. *Piwonka* teaches the display of two separate sets of character strings without any need to switch to from a default mode to a graphics mode of the BIOS. As such, the Office Action’s allegation of inherency is a mere possibility, which is insufficient to establish inherency. To the extent that the Office Action continues to rely on inherency, the applicant respectfully requests extrinsic evidence showing that the alleged inherent characteristic necessarily flows from the teachings of the cited art.

Accordingly, *Piwonka* and *HTML*, alone or in combination, do not teach, suggest, or describe each and every element of independent claim 12. The Applicant therefore submits that

this claim is in condition for immediate allowance. The Applicant further submits that claims 13-14 are also patentable because they contain recitations not taught by *Piwonka* or *HTML* and because these claims depend from allowable independent claim 12. Accordingly, the Applicant submits that claims 12-14 are in condition for immediate allowance.

Claim 15

As addressed in greater detail above with respect to claims 1, 9, and 12, neither *Piwonka* nor *HTML*, alone or combination, describes, teaches or suggests the “BIOS-readable first escape code,” the “the BIOS-readable cancel escape code,” or the “BIOS-readable second escape code,” as recited in amended claim 15. The Applicant further submits that neither *Piwonka* nor *HTML*, alone or combination, describes, teaches or suggests the “BIOS-readable third escape,” also as recited in amended claim 15. In particular, *HTML* code is not “BIOS-readable.”

Accordingly, *Piwonka* and *HTML*, alone or in combination, do not teach, suggest, or describe each and every element of independent claim 15. The Applicant therefore submits that this claim is in condition for immediate allowance. The Applicant further submits that claims 19-22 are also patentable because they contain recitations not taught by *Piwonka* or *HTML* and because these claims depend from allowable independent claim 15. Accordingly, the Applicant submits that claims 19-22 are in condition for immediate allowance.

**Conclusion**

In view of the foregoing amendment and remarks, the applicant respectfully submits that all of the pending claims in the present application are in condition for allowance. Reconsideration and reexamination of the application and allowance of the claims at an early date is solicited. If the Examiner has any questions or comments concerning this matter, the Examiner is invited to contact the applicant's undersigned attorney at the number below.

Respectfully submitted,

HOPE BALDAUFF HARTMAN, LLC

/Steven Koon Hon Wong/

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"Steven" Koon Hon Wong  
Reg. No. 48,459

Hope Baldauff Hartman, LLC  
1720 Peachtree Street, N.W.  
Suite 1010  
Atlanta, Georgia 30309  
Telephone: 404.815.1900

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